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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,394	09/24/2003	Karlheinz Bartzke	GK-ZEI-3217 / 500343.2022	3961
7590 07/12/2006			EXAMINER	
Gerald H. Kiel, Esq. REED SMITH LLP 599 Lexington Avenue New York, NY 10022-7650			DINH, JACK	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,394

Applicant(s)

BARTZKE ET AL.

Examiner

Jack Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 15, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input checked="" type="checkbox"/> Other: <u>DETAILED ACTION</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 10, “pair of foils” lacks antecedent basis.

Regarding claim 8, the phrase “second levers” renders the claim indefinite. “Second levers” are recited without reciting “first levers”. Therefore, it is unclear of the configuration being claimed.

Regarding claim 11, line 2, the term “preferably” renders the claim indefinite. It is unclear whether the limitations after the term are claimed. In addition, it is unclear of the quantity of the “plates” and the number of foils attached to each plate. Therefore, it is unclear of the configuration being claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 15 are rejected under 35 U.S.C. 102(b) as being unpatentable by Hanada (US Patent 5,400,170).

Regarding claim 1, Hanada (figures 2 and 3) is interpreted as disclosing an adjustable pinhole for the illumination beam path of a laser scanning microscope, comprising that the pinhole 2 is defined by foil edges which are adjustable relative to one another, the foils have solid-state joints (see reference 7 of figure 2), which are driven by motor 5 are provided for adjusting the foil edges, a referencing of the stepping motor drive is carried out by means of a path measuring system and/or an optical detector for detecting the amount of light passing through the pinhole (col. 2, lines 48-67), wherein the pinhole can be closed in such a way that the foils overlap and at least the foils has an offset to prevent collision (see figure).

Regarding claim 2, Hanada (figure 3) is interpreted as further disclosing that wherein at least two foils 1, each with at least one straight edge 2, are arranged relative to one another and/or connected to one another in such a way that their edges describe an L-shape and the L-shaped connection pieces are arranged on one another in such a way that they define a rhombic

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or square light passage and are moved relative to one another for adjusting the pinhole (col. 4, lines 1-30).

Regarding claim 3, Hanada (figure 3) is interpreted as further disclosing that the movement direction is the direction of the bisecting line of the angle defined by the L-shape or of another angle lying within the defined angle.

Regarding claim 15, the process for manufacturing an adjustable pinhole comprising the step of producing foil edges defining the pinhole by cutting the foil material in a straight line individually or in composite on at least one side would be inherent from Hanada's figure 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanada (US Patent 5,400,170), as applied to claim 15, in view of Bell et al. (US Patent 5,105,582).

Regarding claim 16, Hanada is interpreted as disclosing all the claimed limitations as described above except that the foil edges are treated, preferably by grinding, subsequent to cutting. Within the same field of endeavor, Bell is interpreted as disclosing the teaching that

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sharpening can be accomplished by grinding a cutting surface to form sharp edges (col. 3, lines 1-3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to grind the cut edges for the purpose of sharpening the edges and improving accuracy.

Response to Arguments

4. Applicant's arguments with respect to claims 1-3 and 11 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 15 and 16 have been fully considered but they are not persuasive.

Regarding claim 15, the Applicant argues that in contrast to the method disclosed in Hanada, the present invention provides a highly accurate pinhole which can be closed in a light-tight manner and whose aperture has a square shape at values above zero. However, the Applicant's argument does not use the language taken directly from the claim. Therefore, the argument is not persuasive.

Regarding claim 16, in response to applicant's argument that Bell (US Patent 5,105,582) is nonanalogous art, the Examiner does not rely on Bell to teach a laser scanning microscope. Instead, the Examiner only rely on Bell's teaching to show an obvious concept that sharpening can be accomplished by grinding a cutting surface to form sharp edges.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Dinh whose telephone number is 571-272-2327. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack, can be reached at 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jack Dinh
07/05/06

A handwritten signature in black ink, appearing to read 'Loha Ben', with a stylized flourish at the end.

Loha Ben
Primary Examiner